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EXAMINER	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	**Application No.** 10/681,949	**Applicant(s)** FISH ET AL.	
	Examiner GIGI L. DUBASKY	**Art Unit** 2421	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on 19 January 2010.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-6,12,13,15-28,30-32,34-39 and 41-46 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-6,12,13,15-28,30-32,34-39 and 41-46 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 01/19/2010 has been entered.

Response to Arguments

Claims 7-11, 14, 29, 33 and 40 have been cancelled.

Claims 44-46 have been newly added.

Claims 1-6, 12-13, 15-28, 30-32, 34-39 and 41-46 are pending.

The objections to claims 3, 6 and 10 have been withdrawn in view of the amendments and cancellation of the claims.

The rejection of claims 8-10 under 35 U.S.C. § 112, second paragraph, has been withdrawn in view of the cancellation of the claims.

2. Applicant's arguments in the Remarks filled on 01/19/2010 have been considered but are moot in view of the new ground(s) of rejection.

Although a new ground of rejection has been used to address additional limitation that has been added to claims, a response is considered necessary for applicant's arguments since the reference Rao will continue to be used to meet several claimed limitations.

In response to the Applicants' arguments on pages 12-13 that "Rao discloses a system with only two components…there is no third component as disclosed in the claimed", examiner respectfully disagrees.

Rao definitely discloses a system with more than two components (see Figures 2, 4 and 5) such as a first component (PVR 110 in Figures 2-5), a second component (recording station 210, 410 and 510 in Figure 2, 4 and 5 respectively) and a third component (handheld device 250, 450 in Figure 2 and 4-5 respectively). And of course, those components are assembled separated from each other as showed in the above mentioned Figures.

Miscellaneous

The claim 44 recites the limitation of **"configured to"**. The claim languages of **"adapted to", "adapted for"**, **"configured for"**, **"configured to"** and "**capable of**" may raise a question as to limiting effect of the language in a claim. This list of examples is not intended to be exhaustive. The subject matter of a properly construed claim is defined by the terms that limit its scope. The language, which suggests or makes optional but does not require steps to be performed or which does not limit a claim to a particular structure, is improper. See MPEP 2111.04.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 43 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 43 depends on a cancelled claim 8. Therefore, the scope of the claim can not be determined. It should be cancelled as well or appropriately amended.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 12-13, 15-22, 28, 36-39 and 43 are rejected under 35 U.S.C. 102(e) as being anticipated by Rao et al (US 2004/0250291).

Regarding claim 12, Rao discloses a system for automatically creating a digitized copy of a recorded program from a personal video recorder (Figure 1), said personal video recorder generating a control signal to an external device indicating the commencement or conclusion of playback of said recorded program (¶ [0026] lines 12-19 for sending a command signal from the PVR to recording station (as an external device) to start encoding and storing the media content), said personal video recorder selectively outputting said recorded program as an output signal including a respective analog video component and an analog audio component (¶ [0020] lines 1-7 for transmitting audio and video from PVR to the PMCD as analog signals), the system comprising:

an analog-to-digital video and audio converter for digitizing the analog video and audio component to create a digitized video and audio signal (¶ [0020] lines 7-11);

a receiver for receiving said control signal from the personal video recorder (element 162 in Figure 1 as a control signal receiver to receive signal from PVR); and

a digital storage device ("HD 158" in Figure 1) for storing the digitized video signal and the digitized audio signal (¶ [0020] lines 16-19 for storing transcoded video and audio signals in digital format on storage device 158).

Regarding claims 13 and 15-16, Rao discloses the system as discussed in the rejection of claim 12. Rao further discloses a first compression unit utilizing an electronic circuit computer based software that compresses the digitized video signal to produce a compressed digitized video signal and a second compression unit for compressing the digitized audio signal to produce a compressed digitized audio signal (¶ [0026] lines 31-34 for the stored compressed video/audio signal is decoded to display. It is clearly that Rao's system must include compression unit for compressing video and audio signals to store; ¶ [0035] for a PC is used as a recording station and PC contain software necessary to perform all functions of the recording station).

Regarding claim 17, all limitations of claim 17 are analyzed corresponding to claim 10. So, claim 17 is rejected on the same ground as claim 10.

Regarding claims 18-20, Rao discloses the system as discussed in the rejection of claim 12. Rao further discloses a network interface subsystem for sharing the digitized video signal and the digitized audio signal with other computer systems on a computer network (¶ [0023] lines 11-16 for wirelessly transferring the transcoded media content from a first PMCD to a second PMCD over a Bluetooth or an IEEE 802.11 network; and ¶ [0035] for a PC is used as a recording station and PC contain software necessary to perform all functions of the recording station), network is client-server (¶ [0026] lines 12-14 for PVR and recording station as a master and slave) and peer-to-peer (¶ [0023] lines 10-16).

Regarding claims 21-22, Rao discloses the system as discussed in the rejection of claim 12. Rao further discloses a storage system with removable medium for storing the digitized video signal and the digitized audio signal on a write-once and rewritable removable medium (¶ [0031] for handheld device functions as a removable storage and a playback device; and ¶ [0033] lines 7-14 for storage device within handheld device can be removed and inserted into either PVR or recording station to receive transcoded signal and then reinserted into handheld device to play back).

Regarding claim 28, all limitations of a method in claim 28 are analyzed and rejected corresponding to all functionalities of the system in claim 12.

Regarding claim 36, Rao discloses the method as discussed in the rejection of claim 28. Rao further discloses transmitting the digitized video and audio components over a network (¶ [0023] lines 11-16 for wirelessly transferring the transcoded media content from a first PMCD to a second PMCD over a Bluetooth or an IEEE 802.11 network).

Regarding claim 37, Rao discloses the method as discussed in the rejection of claim 28. Rao further discloses sharing the video and audio subcomponents in a peer-to-peer network configuration (¶ [0023] lines 11-16 for using a Bluetooth network interface to transfer media content between the PMCDs. In other words, the PMCD shares media content in a peer-to-peer network; and ¶ [0026] lines 31-34 for the stored compressed video/audio signal is decoded to display).

Regarding claim 38, Rao discloses the method as discussed in the rejection of claim 28. Rao further discloses recording the video and audio subcomponents onto a transportable digital storage medium (¶ [0033] lines 7-14 for storage device within handheld device can be removed and inserted into other device).

Regarding claim 39, Rao discloses the method as discussed in the rejection of claim 38. Rao further discloses the transportable digital storage media is an optical media (taught by Rao; ¶ [0036] lines 19-22).

Regarding claim 43, Rao discloses a recording member that records said digitized version on a digital media (¶ [0020] lines 16-19 for storing transcoded signals in digital format on storage device 158 in Figure 1).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. Claims 1-6, 23-27 and 44-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lim et al (US 2002/0126986) in view of Rao et al (US 2004/0250291).

Regarding claim 1, Lim discloses in a system including a personal video recorder (PVR) receiving and recording a program (“DVR 220” with pre-recorded programs in Figure 2) and having a PVR program output (“audio/video cables 272” in Figure 2) generating a PVR signal corresponding to said program (¶ [0035] lines 6-10) and a command output (“IR Emitter cable 260” in Figure 2) generating command signal (¶ [0035] lines 1-6), and a video recorder (“VCR 230” in Figure 2) assembly, a method for automated copying from said personal video recorder (¶ [0003]), the method comprising the steps of:

generating a command signal by said PVR to said video recorder instructing the video recorder to start recording (¶ [0048] for providing selectable options to user via an interface as in Figure 4 and "Save to VCR” command is one of these options; and ¶ [0052] for issuing a "record" command from the DVR to the VCR to instruct VCR to start recording);

transmitting content signal from the personal video recorder (¶ [0032] for automatically transmitting pre-recorded television programs from the DVR/PVR to the remote electronic device (VCR)), wherein the content signal is an analog signal containing said program (¶ [0048] for including the option of “Save to VCR" command which will take a digitally recorded program from the DVR and pass an analog copy of the program to a

VCR to record on tape. It means that the VCR receives an analog signal containing television program from the DVR).

Lim does not explicitly disclose a digitizer to intercept said command signal and said content signal, in response to said command signal, digitizing the content signal to create a digital representation of the program and storing the digital representation by said digitizer assembly.

Rao discloses a system which enables to transcode media content from a personal video recorder (PVR) for a portable device (title). The system includes a PVR, a recording station as standalone appliance (has equal functionality as "a digitizer") and a handheld device (Figures 2 and 4-5). Rao discloses when the user requests to transfer content to handheld device by using PVR’s remote control, PVR sends a signal via control channel which allows user input to one system to be passed to the other (¶ [0019] lines 10-11) to recording station to start encoding content (¶ [0026] lines 14-19) received from media channel (“A/V out 124A or 124B” in Figures 2 and 4-5) as an analog signal (¶ [0020] lines 6-12). In other words, the command signal from PVR's remote control is transferred to recording station via control channel and the analog content signal via media channel in response to user’s request to transfer content to handheld device via PVR’s remote control or the command signal and content signal are intercepted by the recording station via control channel and media channel. Moreover, Rao discloses receiving analog media content from PVR to transcode into suitable format in response to user’s command via PVR’s remote control (¶ [0026] lines 14-27), converting the received analog media content to digital format (¶ [0020] lines 6-

11) and storing transcoded media content in digital form by the recording station (¶ [0020] lines 16-19 and ¶ [0026] lines 27-28).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Lim's system with the recording station to automatically convert, digitalize and store the content as taught by Rao, so to provide an enhanced system that enables to copy recorded programs from the PVR into not only an analog version via a VCR but also an digital version on a removable storage medium via a recording station (a digitizer) for later playback on different type of devices.

Regarding claim 2, Lim in view of Rao discloses the method as discussed in the rejection of claim 1. The combined system further discloses transmitting the digital representation over a network (taught by Rao; ¶ [0023] lines 11-16 for wirelessly transferring the transcoded media content from a first PMCD to a second PMCD over a Bluetooth or an IEEE 802.11 network).

Regarding claim 3, Lim in view of Rao discloses the method as discussed in the rejection of claim 2. The combined system further discloses sharing the digital representation in a peer-to-peer network configuration (taught by Rao; ¶ [0023] lines 11-16 for using a Bluetooth network interface to transfer media content between the PMCDs. In other words, the PMCD shares media content in a peer-to-peer network;

and ¶ [0026] lines 31-34 for the stored compressed video/audio signal is decoded to display).

Regarding claim 4, Lim in view of Rao discloses the method as discussed in the rejection of claim 1. The combined system further discloses recording the digital representation onto a digital storage medium (taught by Rao; ¶ [0020] lines 16-19 for storing transcoded signals in digital format on storage device 158 in Figure 1).

Regarding claim 5, Lim in view of Rao discloses the method as discussed in the rejection of claim 4. The combined system further discloses recording is performed on a transportable digital storage medium (taught by Rao; ¶ [0033] lines 7-14 for storage device within handheld device can be removed and inserted into other device).

Regarding claim 6, Lim in view of Rao discloses the method as discussed in the rejection of claim 1. The combined system further discloses the step of compressing the digital representation and storing the compressed digital representation (taught by Rao; ¶ [0026] lines 31-34 for the stored compressed video/audio signal is decoded to display).

Regarding claim 23, Lim discloses a method for automated copying of content from a personal video recorder, the method comprising the steps of generating command signal by the personal video recorder wherein the command signal is indicative of the initiation of a playback of the content from the personal video recorder, said command being generated for the control of an analog video cassette recorder (¶ [0044] and ¶ [0052] for the DVR/PVR sends commands to a VCR such as turn on the power, start and stop recording the contents via IR interface and sends video/audio content to VCR via video/audio cable interface) and generating a video signal which is an analog signal containing a video component of content (¶ [0048] for including “Save to VCR” command that will take a digitally recorded program and pass an analog copy of the program to a VCR to save on tape. It means that the VCR receives an analog signal containing television program from the DVR).

Lim fails to disclose a digitizer that is separate from the PVR and the VCR to intercept said command signal and video signal from the PVR, to digitize the video component signal to create a digitized version of the content, to digitize the information and to store the video component and the information.

Rao discloses a system which enables to transcode media content from a personal video recorder (PVR) for a portable device (title). The system includes a PVR, a recording station as standalone appliance (has equal functionality as "a digitizer") and a handheld device (Figures 2 and 4-5). Rao discloses when the user requests to transfer content to handheld device by using PVR’s remote control, PVR sends a signal via control channel which allows user input to one system to be passed to the other (¶ [0019] lines 10-11) to recording station to start encoding content (¶ [0026] lines 14-19). In other words, Rao discloses the command signal from PVR's remote control is transferred to recording station via control channel or intercepted by the recording station via control channel. The recording station receives an analog media content from PVR to transcode into suitable format in response to user's command via PVR's remote control (¶ [0026] lines 14-27), converts the received analog media content to digital format (¶ [0020] lines 6-11) and stores the transcoded media content and metadata of content in digital form (¶ [0020] lines 16-19 and ¶ [0026] lines 24-28).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Lim's system with the teaching of Rao, so to provide an enhanced system that enables to copy recorded programs from the PVR into not only an analog version but also an digital version on a removable storage medium for later playback.

Regarding claim 24, all limitations of claim 24 are analyzed corresponding to claim 2. So, claim 24 is rejected under the same rationale as claim 2.

Regarding claim 25, all limitations of claim 25 are analyzed corresponding to claim 3. So, claim 25 is rejected under the same rationale as claim 3.

Regarding claim 26, all limitations of claim 26 are analyzed corresponding to claim 5. So, claim 26 is rejected under the same rationale as claim 5.

Regarding claim 27, Lim in view of Rao discloses the method as discussed in the rejection of claim 26. The combined system further discloses the digital storage media is an optical media (taught by Rao; ¶ [0036] lines 19-22).

Regarding claim 44, all limitations of claim 44 are analyzed corresponding to claim 1. So, claim 44 is rejected on the same ground as claim 1.

Regarding claim 45, Lim in view of Rao discloses the method as discussed in the rejection of claim 44. The combined system further discloses the video signal includes an analog video and an analog audio component and said digitizer converts analog audio and video components into corresponding digital audio and video components (¶ [0020]) and to store said components (¶ [0026] lines 24-28).

Regarding claim 46, all limitations of claim 46 are analyzed corresponding to claim 4. So, claim 44 is rejected on the same ground as claim 4.

9. Claims 30-32, 34-35, 41-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rao et al (US 2004/0250291) in view of Kimball of record.

Regarding claims 30-32, Rao discloses the method as discussed in the rejection of claim 28. Rao further discloses the metadata associated with the media content (¶ [0013] lines 7-10).

Rao does not explicitly disclose the metadata (data subcomponent) is imbedded in video component and is encoded within a vertical blanking interval of said video component.

Kimball discloses the video encoder outputs an analog video signal and the content advisory rating information is inserted into the analog video signal. The content advisory rating information is also additional information related to the playback video (¶ [0060] lines 7-16). The data information is encoded within a vertical blanking interval of the video signal (¶ [0048]).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Rao's system with the teaching of Kimball about receiving analog audio video signals containing additional information from the PVR and encoding data information within a VBI of video signal, so to provide a flexible system that enables to work compatibly with the conventional PVR system, to control the content based on the inserted additional information and to minimize the bandwidth by encoding data information into VBI of video signal.

Regarding claim 34, Rao in view of Kimball discloses the method as discussed in the rejection of claim 30. The combined system further discloses storing said digitized data together with said digitized video and audio components (taught by Rao; (¶ [0020] lines 16-19 and ¶ [0026] lines 24-28 for storing transcoded media content in digital form by the recording station).

Regarding claim 35, Rao discloses the method as discussed in the rejection of claim 28. Modifying Rao's system with the teaching of Kimball with the same motivation as discussed in claim 30, the combined system discloses the data component is disposed within a blanking interval of the video component (taught by Kimball; ¶ [0048]).

Regarding claim 41, Rao in view of Kimball discloses the method as discussed in the rejection of claim 32. The combined system further discloses the signal is an analog signal (taught by Rao; ¶ [0020] lines 6-7), further comprising digitizing the signal (taught by Rao; ¶ [0020] lines 7-11), compressing the digitized signal and storing the compressed signal (taught by Rao; (¶ [0026] lines 31-34 for the stored compressed video/audio signal is decoded to display).

Regarding claim 42, Rao in view of Kimball discloses the method as discussed in the rejection of claim 32. The combined system further discloses signal is an encoded digital signal, further comprising decoding the digital signal and storing the decoded signal (taught by Rao; ¶ [0020]).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to GIGI L. DUBASKY whose telephone number is

(571)270-5686. The examiner can normally be reached on Monday through Thursday from 8:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Miller can be reached on 571-272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/John W. Miller/
Supervisory Patent Examiner, Art Unit 2421

GD